

ESTTA Tracking number: **ESTTA123399**

Filing date: **02/05/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Lucasfilm Entertainment Company Ltd.
Granted to Date of previous extension	02/04/2007
Address	P.O. Box 29919 San Francisco, CA 94129-0908 UNITED STATES
Attorney information	Carole F. Barrett Howard Rice et alia Three Embarcadero Center, 7th Floor San Francisco, CA 94111-4024 UNITED STATES trademark@howardrice.com, cbarrett@howardrice.com, mschreier@howardrice.com Phone:415-434-1600

Applicant Information

Application No	78542038	Publication date	08/08/2006
Opposition Filing Date	02/05/2007	Opposition Period Ends	02/04/2007
Applicant	DIGG INC. 135 MISSISSIPPI STREET, 3RD FLOOR SAN FRANCISCO, CA 94107 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2004/12/01 First Use In Commerce: 2004/12/01 All goods and services in the class are opposed, namely: Providing online news and information in the field of technology, namely, computer games and computer enhancements for games
Class 042. First Use: 2004/12/01 First Use In Commerce: 2004/12/01 All goods and services in the class are opposed, namely: Providing online news and information in the field of technology, namely, computer software and hardware; providing customized online web pages featuring user defined information, which includes search engines and online links to other websites

Attachments	DIGG Notice of Opposition 78542038.pdf (11 pages)(481670 bytes)
Signature	/CFB_mws/
Name	Carole F. Barrett
Date	02/05/2007

Certificate of Mailing

I hereby certify that this correspondence is being deposited electronically the Trademark Trial and Appeal Board on the date shown below.



Carole F. Barrett

Dated: February 5, 2006

Attorney Docket No. 40054.307

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Lucasfilm Entertainment Company Ltd.

Opposer,

v.

DIGG INC.

Applicant.

Trademark Application

Mark: DIGG

Serial No. 78/542038

Filed: January 12, 2006

Published: June 14, 2006

Opposition No. _____

NOTICE OF OPPOSITION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

Sir:

Lucasfilm Entertainment Company Ltd., a California corporation, located and doing business at P.O. Box 29919, itself and through its LucasArts' business unit ("Lucasfilm" or "Opposer"), believes that it will be damaged by registration by DIGG INC. ("Digg" or "Applicant") of the mark DIGG shown in Application Serial No. 78/542038 and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Digg filed a trademark application assigned Application Serial No. 78/542038 in the

United States Patent and Trademark Office (“PTO”) on January 4, 2005 (“the Application”) to register the mark DIGG (“the Applicant’s Mark”) for use in connection with “providing online news and information in the field of technology, namely, computer games and computer enhancements for games in International Class 41 and for providing online news and information in the field of technology, namely, computer software and hardware; providing customized online web pages featuring user defined information, which includes search engines and online links to other websites in International Class 42. (“the Applicant’s Services”).

2. The Application filed by Digg on January 14, 2005 (“the Applicant’s Filing Date”) was based on Digg’s alleged use of the Applicant’s Mark with the Applicant’s Services on or before December 1, 2004. (“the Applicant’s Alleged First Use Date”).
3. The Application for the Applicant’s Mark was published for opposition in the *Official Gazette* on August 8, 2006. On September 6, 2006, the Opposer timely filed a request for a 90-day extension of time to oppose the Application for Applicant’s Mark, which was granted until December 6, 2006. On December 4, 2006, the Opposer timely filed a 60 day Request for Extension of Time to Oppose Applicant’s Mark Upon Consent, which was granted until February 4, 2007.
4. The Opposer is a well-known provider of computer and video interactive entertainment products, including interactive game software, computer games, games for mobile/wireless devices, among others (collectively “Computer Games”) as well as toys, films, and other entertainment-related goods and services. The Computer Games produced and distributed by Opposer include a wide range of titles related to fantasy, e.g.,

STAR WARS, and action and adventure, e.g. INDIANA JONES and MONKEY ISLAND and THE DIG. The Opposer provides information about its Computer Games and other entertainment-related goods and services on-line, including sites that are sponsored by Opposer, for example, www.starwars.com; www.lucasarts.com; and www.indianajones.com (“the Opposer’s Websites”). Websites of third parties also include information about the Opposer’s Computer Games and its other entertainment-related goods and services (“Third Party Websites”).

5. The Opposer is the owner of U.S. Registration Number 2,018,166 for the mark THE DIG (“the Opposer’s Mark”) filed in the PTO on August 25, 1994 (“the Opposer’s Filing Date”) based on its bona fide intention to use the Opposer’s Mark. On July 26, 1996, the Opposer filed proof with the PTO of its use of the Opposer’s Mark with “interactive game software and documentation distributed as a unit” (“the Opposer’s Goods”) and an Amendment to Allege Use of the Opposer’s Mark with a date of first use of November 15, 1995 (“the Opposer’s First Use Date”). The PTO accepted the Opposer’s proof of use and the Amendment to Allege Use. The Opposer’s Mark was registered as U. S. Registration No. 2,018,166 on November 19, 1996 (“Opposer’s Registration”). One copy of the Trademark Assignment Abstract of Title is attached hereto as Exhibit A, showing the chain of title of the Opposer’s Mark. One copy of the TTAB record showing the current active status of the registration of the Opposer’s Mark is attached as Exhibit B.
6. On January 29, 2002, a Combined Declaration of Use in Commerce and Incontestability under Sections 8 and 15 was filed by the Opposer for the Opposer’s Registration. On January 7, 2003, the Declaration Under Section 8 was accepted and the Declaration of

Incontestability under Section 15 for the Opposer's Registration was acknowledged. The Opposer's Registration for THE DIG is incontestable.

7. On November 21, 2006, the Opposer timely filed a Combined Declaration of Use in Commerce and Application for Renewal Under Sections 8 and 9 for the Opposer's Mark.
8. The Opposer has used the Opposer's Mark in association with the Opposer's Goods in commerce since at least as early as November 15, 1995 and the Opposer's Mark is currently in use in commerce with Opposer's Goods.
9. The Opposer's Filing Date and the Opposer's First Use Date for the Opposer's Mark is earlier than the Applicant's Alleged First Use Date for the Applicant's Mark.
10. The Opposer's Filing Date and the Opposer's First Use Date for the Opposer's Mark is earlier than the Applicant's Filing Date for the Applicant's Mark.
11. Priority is not an issue in this case because both the Opposer's Filing Date and the Opposer's First Use Date for the Opposer's Mark precede the Applicant's Filing Date and the Applicant's Alleged First Use Date for the Applicant's Mark.
12. Applicant's Mark DIGG is identical or nearly identical to the Opposer's Mark THE DIG. The word "the" included in Opposer's Mark is one of the most commonly used English words and its presence or absence is of little note to consumers. The Applicant's the DIGG Mark is confusingly similar in sound, meaning, and appearance to the Opposer's THE DIG Mark. The Applicant's registration and use of the DIGG Mark would likely create confusion, mistake, or deception in the minds of prospective purchasers as to the origin or source of the Opposer's Goods associated with THE DIG Mark.

13. The Applicant's Services are closely related to and/or are in the natural zone of expansion of the Opposer's Goods. The Opposer's Goods are advertised and sold on-line on Opposer's Websites and Third Party Websites. The Applicant's Services including providing information about computer games, are the same or substantially similar to those entertainment related services provided by the Opposer on the Opposer's Websites.
14. The Opposer's Goods and the Applicant's Services travel in the same channels of trade and are viewed by the same customers including those who buy and play computer games. Applicant's Services are therefore substantially similar to the Opposer's Goods with which the Opposer's Mark is used.
15. Purchasers familiar with the Opposer's Goods and its entertainment services are likely to mistakenly believe that the Applicant's Services are sponsored by, authorized, endorsed, affiliated with or otherwise approved by the Opposer because the DIGG Mark sought to be registered and used by the Applicant is identical to or confusingly similar to the Opposer's THE DIG Mark .
16. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act, and Opposer believes that it would be damaged thereby.
17. On information and belief, at the time Applicant filed the Application, Applicant did not have actual use of Applicant's Mark as a trademark with each of Applicant's Services.
18. Applicant's Application should not be granted because it was not filed based on Applicant's actual use of Applicant's Mark as a trademark with each and every one of


Applicant's Services, and on information and belief, Applicant failed to satisfy the requirements of Trademark Act Section 1(a) and related Trademark Rules and Regulations.

19. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act, and Opposer believes that it would be damaged thereby.
20. WHEREFORE, Opposer respectfully requests that registration of the mark shown in Application Serial No. 78/542,038 be refused and that this Opposition be sustained in favor of Opposer.

Please deduct the filing fees of \$600 from Deposit Account No. 082792. Please deduct any additional fees that may be due, or credit any overpayment, to the same deposit account.

DATED: February 5, 2006

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CAROLE F. BARRETT
Attorney for Opposer
Lucasfilm Entertainment Company Ltd.

EXHIBIT A



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Trademark Assignment Abstract of Title

Total Assignments: 5**Serial #:** 74565616**Filing Dt:** 08/25/1994**Reg #:** 2018166**Reg. Dt:** 11/19/1996**Registrant:** LucasArts Entertainment Company**Mark:** THE DIG**Assignment: 1****Reel/Frame:** 2586/0013**Received:** 09/20/2002**Recorded:** 09/18/2002**Pages:** 4**Conveyance:** CHANGE OF NAME**Assignor:** LUCASARTS ENTERTAINMENT COMPANY, LLC**Exec Dt:** 09/27/1997**Entity Type:** LIMITED LIABILITY COMPANY**Citizenship:** DELAWARE**Assignee:** LUCASARTS ENTERTAINMENT COMPANY LLC

1600 LOS GAMOS

SAN RAFAEL, CALIFORNIA 94903

Entity Type: LIMITED LIABILITY COMPANY**Citizenship:** DELAWARE**Correspondent:** HOWARD, RICE, NEMEROVSKI & ET AL.

CAROLE F. BARRETT, ESQ.

THREE EMBARCADERO CTR. 7TH FL.

SAN FRANCISCO, CA 94111

Assignment: 2**Reel/Frame:** 1798/0334**Received:** 01/28/1999**Recorded:** 01/19/1999**Pages:** 6**Conveyance:** CORRECTIVE ASSIGNMENT TO CORRECT THE ASSIGNOR AND ASSIGNEE ENTITY TYPE, AND AN ERROR IN THE REG. NO. 1,877,718, FILED ON 12/16/97. DOCUMENT RERECORDED TO CORRECT ERRORS ON REEL 1666, FRAME 0774.**Assignor:** LUCAS ARTS ENTERTAINMENT COMPANY**Exec Dt:** 09/29/1997**Entity Type:** LIMITED LIABILITY COMPANY**Citizenship:** DELAWARE**Assignee:** LUCASARTS ENTERTAINMENT COMPANY LLC

P.O. BOX 10307

SAN RAFAEL, CALIFORNIA 94912

Entity Type: LIMITED LIABILITY COMPANY**Citizenship:** DELAWARE**Correspondent:** FENWICK & WEST LLP

JOHN J. SULLIVAN, ESQ.

100 THE EMBARCADERO

SUITE 300

SAN FRANCISCO, CA 94105

Assignment: 3**Reel/Frame:** 2585/0988**Received:** 09/20/2002**Recorded:** 09/18/2002**Pages:** 3**Conveyance:** MERGER**Assignor:** LUCASARTS ENTERTAINMENT COMPANY**Exec Dt:** 09/29/1997**Entity Type:** CORPORATION

Assignee: LUCASARTS ENTERTAINMENT COMPANY, LLC
1600 LOS GAMOS
SAN RAFAEL, CALIFORNIA 94903

Citizenship: NONE

Entity Type: LIMITED LIABILITY
COMPANY

Citizenship: DELAWARE

Correspondent: HOWARD, RICE, NEMEROVSKI, CANADY, ET AL.
CAROLE F. BARRETT, ESQ.
THREE EMBARCADERO CENTER, 7TH FLOOR
SAN FRANCISCO, CA 94111

Assignment: 4

Reel/Frame: 1666/0774 **Received:** 12/29/1997 **Recorded:** 12/16/1997 **Pages:** 6

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: LUCASARTS ENTERTAINMENT COMPANY

Exec Dt: 12/08/1997

Entity Type: CORPORATION

Citizenship: CALIFORNIA

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: LUCASARTS ENTERTAINMENT COMPANY LLC
P.O. BOX 10307
SAN RAFAEL, CALIFORNIA 94912

Correspondent: FENWICH & WEST LLP
JOHN J. SULLIVAN, ESQ.
100 THE EMBARCADERO
SUITE 300
SAN FRANCISCO, CA 94105

Assignment: 5

Reel/Frame: 3288/0486 **Received:** 04/12/2006 **Recorded:** 04/12/2006 **Pages:** 11

Conveyance: MERGER

Assignor: LUCASARTS ENTERTAINMENT COMPANY LLC

Exec Dt: 03/31/2003

Entity Type: LIMITED LIABILITY
COMPANY

Citizenship: DELAWARE

Entity Type: CORPORATION

Citizenship: CALIFORNIA

Assignee: LUCASFILM ENTERTAINMENT COMPANY LTD.
PO BOX 29919
SAN FRANCISCO, CALIFORNIA 94129

Correspondent: ROSEMARY S. TARLTON
MORRISON & FOERSTER LLP, 425 MARKET ST.
SAN FRANCISCO, CA 94105-2482

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EXHIBIT B

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Barnes & Thornburg LLP
11 S. Meridian Street
Indianapolis, IN 46204**Serial #:** 78542038**Application Status:** Request For Extension of Time to File Opposition**Mark:** DIGG**Potential Opposer****Name:** Lucasfilm Entertainment Company Ltd.**Correspondence:** Carole F. Barrett
Howard Rice et alia
Three Embarcadero Center, 7th Floor
San Francisco, CA 94111-4024
trademark@howardrice.com**Granted To Date:** 02/04/2007**Prosecution History**

#	Date	History Text
4	12/04/2006	EXTENSION OF TIME GRANTED
3	12/04/2006	INCOMING - EXT TIME TO OPPOSE FILED
2	09/07/2006	EXTENSION OF TIME GRANTED
1	09/06/2006	INCOMING - EXT TIME TO OPPOSE FILED

Results as of 02/05/2007 01:00 PM

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